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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,119	06/02/2000	Michael D. Hamerski	55420USA9A.002	6205

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

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DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/586,119

Applicant(s)

HAMERSKI, MICHAEL D.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 26-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13-²⁴~~25~~ are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. More particularly, Applicants' Specification and response indicate that the use of stretch releasing adhesive is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

For example, Applicants indicated that removing the adhesive tape by applying a force to the pull tab is critical to a simultaneous progressive debonding process (e.g., Response, page 4, 4th paragraph). As such, the "stretch releasing adhesive" should be incorporated in all the independent claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that ~~the~~ many claims in their present form are replete with redundant, vague and indefinite phrases, rendering the claims incomprehensible. For example:

In claim 1, line 2, the Examiner suggests insert --said article-- before "comprising", and delete "adhesive article having an" after "stretch releasing".

Also for claim 1, line 4, the phrase "reduced adhesive properties" is vague and indefinite, i.e., it is not clear to the Examiner just exactly what is encompassed by this vague, indefinite and confusing statement.

Still for claim 1, lines 5-6, the Examiner suggests replace "the stretch releasing adhesive article" with --said article--, and delete "the stretch releasing adhesive article adjacent to" in line 6.

In claims 2-4, line 2 in each claim, the term "tape" lacks antecedent basis.

In claim 4, line 4, the term "solid" is vague and definite, and also proper Markush language should be used in place of "comprises".

In claims 6, 7, 13, 17, etc., again, the phrase "reduced adhesive properties" is vague and indefinite.

Claims 9 and 10, and claims 22 and 23, are de facto duplicates of each other, respectively.

Claims 11 and 24 are incomprehensible as to selecting non-adhesive materials to be used as "adhesive" in the second region, i.e., it appears these are materials useable to treat the adhesive for reduced adhesive properties.

For claim 17 in particular, as well as remaining claims, the Examiner strongly suggests that the claim language needs to be much more precise than what currently exists.

7. Claims 13, 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3340598A (Abstract) either individually, or in view of JP 2001-279198 (Abstract and English translation).

DE '598 is directed to a frameless picture holder comprises a backing wall and a transparent front wall detachably fixing onto same by means of double-sided adhesive fastening elements. The pictures in the frame can be easily replaced when required by pulling the two walls apart and refitting using the adhesive strips (Abstract).

For claims 13, 17, 24 and 25, DE '598 lacks specific teaching of having a second region with reduced adhesive properties. However, it is believed that incorporating a region with reduced adhesiveness at the end to be detached first is common and well known. Alternatively, JP '198 teaches a pressure sensitive adhesive tape with one end portion of the pressure sensitive adhesive layer having reduced adhesive force for easy application in a continuous feeding operation. The reduced adhesive properties can be provided by either partially covering the adhesive or by applying a weak adhesive (Abstract, [0010] and [0011] of English translation). As such, it would have been obvious to one of ordinary skill in the art of pressure sensitive adhesive to modify DE

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'598 with the end region to be detached having reduced adhesive properties as taught by JP '198, motivated by the desire to improve the detachment process.

For claims 15 and 16, it is believed that the delamination or detachment of a holder or a hook by "reverse peeling" from the end with reduced adhesive is common and well known.

For claims 18-23, it is believed that using progressively reduced adhesive property in plurality of regions is old and well known. Note also as evidence the state of the art Haller (US 6191338) which teaches that it is known to use adhesive layers and regions of lesser adhesiveness along the length of an adhesive tape (column 1, lines 50-54). Further, it is believed that optimizing the suitable amount of area to be covered by the reduced adhesiveness is within the skill of the art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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VSC

January 10, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~

1700

Daniel Zinker